

O I P E 25.3800 PCT/CONT. V



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

STEVEN C. CLARK ET AL.

Application No.: 08/466,308

Filed: June 6, 1995

For: LYMPHOKINE PRODUCTION  
AND PURIFICATION

) : Examiner: Prema Mertz, Ph.D  
): Group Art Unit: 1812  
):  
):  
):  
): March 27, 1998

RECEIVED

Assistant Commissioner for Patents  
Washington, D.C. 20231

APR 01 1998  
MATRIX CUSTOMER  
SERVICE CENTER

PETITION TO WITHDRAW HOLDING OF  
ABANDONMENT UNDER M.P.E.P. § 711.03(c)

Sir:

Applicants respectfully petition the Assistant Commissioner to restore the above-identified abandoned application to pending status on the ground that Applicants never received the Office Action reportedly mailed June 11, 1997.

This Petition is accompanied by:

- (1) a Declaration Under M.P.E.P. § 711.02 of Melvyn M. Kassenoff; and
- (2) a Declaration Under M.P.E.P. § 711.02 of Lawrence S. Perry.

FACTS

On February 13, 1998, Applicants' attorney received a Notice of Abandonment dated February 11, 1998 (paper No. 13, copy enclosed). The Notice indicates that the subject application was abandoned by "Applicant's failure to timely file a proper response to the Office letter mailed on 7-11-97."

However, Applicants' attorney never received the July 11, 1997 Office Action, as evidenced by the attached Declarations of Melvyn M. Kassenoff and Lawrence S. Perry.

REQUEST

In accordance with the practice specified in 1156 OG 53 (Nov. 16, 1993), the Assistant Commissioner is respectfully requested to revive this application by withdrawing the holding of abandonment dated February 11, 1998, and to return the application to the Examiner for appropriate action.

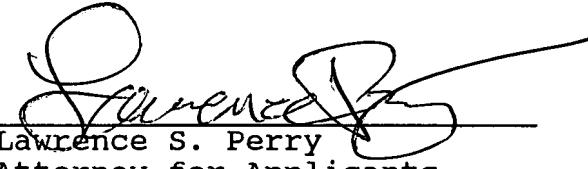
FEE

The Assistant Commissioner is hereby authorized to charge Deposit Account No. 06-1205 for any petition fee which may be due. However, since it is believed that the holding of abandonment is the result of circumstances not attributable to any fault of Applicants or their

representatives, it is respectfully suggested that no fee is due.

Applicants' undersigned attorney may be reached in New York by telephone at (212) 758-2400. As requested previously, and in conformity with the attached Change in Correspondence Address, all correspondence should be directed to our below-listed address.

Respectfully submitted,



Lawrence S. Perry  
Attorney for Applicants  
Registration No. 31,865

FITZPATRICK, CELLA, HARPER & SCINTO  
277 Park Avenue  
New York, New York 10172  
Facsimile: (212) 758-2982

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**UNITED STATES DEPARTMENT OF COMMERCE**  
**Patent and Trademark Office**  
 Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
 Washington, D.C. 20231

06/1466-300

06/06/98

CLARK

APPLICATION NUMBER

FILING DATE

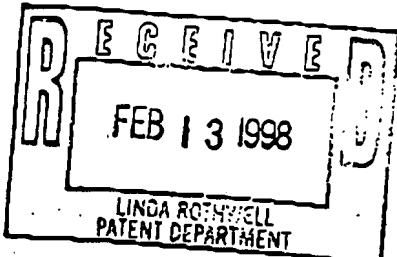
FIRST NAMED APPLICANT

ATTORNEY DOCKET NO.

CONT'S

ROBERT S. HOMER  
 SANODZ CORP.  
 100 ROUTE 16  
 S. PHILADELPHIA, PA. 07382

PMT 1/0211



MARTZ, P.

EXAMINER

1646

ART UNIT

PAPER NUMBER

01/13

DATE MAILED:

**NOTICE OF ABANDONMENT**

This application is abandoned in view of:

Applicant's failure to timely file a proper response to the Office letter mailed on 7-11-97.

A response (with a Certificate of Mailing or Transmission of \_\_\_\_\_) was received on \_\_\_\_\_, which is after the expiration of the period for response (including a total extension of time of \_\_\_\_ month(s)) which expired on \_\_\_\_\_.

A proposed response was received on \_\_\_\_\_, but it does not constitute a proper response to the final rejection.

(A proper response to a final rejection consists only of: a timely filed amendment which places the application in condition for allowance; a Notice of Appeal; or the filing of a continuing application under 37 CFR 1.62 (FWC).)

No response has been received.

Applicant's failure to timely pay the required issue fee within the statutory period of three months from the mailing date of the Notice of Allowance.

The issue fee (with a Certificate of Mailing or Transmission of \_\_\_\_\_) was received on \_\_\_\_\_.

The submitted issue fee of \$\_\_\_\_\_ is insufficient. The issue fee required by 37 CFR 1.18 is \$\_\_\_\_\_.

The issue fee has not been received.

Applicant's failure to timely file new formal drawings as required in the Notice of Allowability.

Proposed new formal drawings (with a Certificate of Mailing or Transmission of \_\_\_\_\_) were received on \_\_\_\_\_.

The proposed new formal drawings filed \_\_\_\_\_ are not acceptable.

No proposed new formal drawings have been received.

The express abandonment under 37 CFR 1.62(g) in favor of the FWC application filed on \_\_\_\_\_.

The letter of express abandonment which is signed by the attorney or agent of record, the assignee of the entire interest, or all of the applicants.

The letter of express abandonment which is signed by an attorney or agent (acting in a representative capacity under 37 CFR 1.34(a)) upon the filing of a continuing application.

The decision by the Board of Patent Appeals and Interferences rendered on \_\_\_\_\_ and because the period for seeking court review of the decision has expired and there are no allowed claims.

The reason(s) below:

2/2  
 JOHN DLM  
 PRIMARY EXAMINER  
 GROUP 1800

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: )  
STEVEN C. CLARK ET AL. ) : Examiner: Prema Mertz, Ph.D  
Application No.: 08/466,308 ) : Group Art Unit: 1812  
Filed: June 6, 1995 ) :  
For: LYMPHOKINE PRODUCTION ) :  
AND PURIFICATION :  
:

Assistant Commissioner for Patents  
Washington, D.C. 20231

DECLARATION OF MELVYN M. KASSENOFF  
UNDER M.P.E.P. § 711.02

Sir:

I, MELVYN M. KASSENOFF, DECLARE AND SAY THAT:

1. I am an attorney in the Patent and Trademark Department of Novartis Corporation (formerly Ciba-Geigy Corporation, into which Sandoz Corporation was merged), 564 Morris Avenue, Summit, NJ 07901-1027 and am an attorney of record in the above-identified application.

2. I am the Novartis Corporation Patent and Trademark Department attorney who is currently primarily responsible for prosecution of the subject patent application. All communications received either from the Patent and Trademark Office or Fitzpatrick, Cella, Harper &

Scinto in this application are directed to me upon receipt by the Patent and Trademark Department of Novartis Corporation.

3. On February 13, 1998 a Notice of Abandonment, bearing a Mailing Date of February 11, 1998, was received by the Patent and Trademark Department of Novartis Corporation in the above-identified patent application. The Notice of Abandonment stated that the application was abandoned due to Applicant's failure to respond to the Office letter mailed July 11, 1997. However, after reviewing the file jacket and the computerized docket records of the Patent and Trademark Department of Novartis Corporation, I concluded that the Department never received the Office letter mailed July 11, 1997. A photocopy of the relevant page of the computerized docket records is appended.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Dated: March 25, 1998

Melvyn M. Kassenoff  
Melvyn M. Kassenoff

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PATENT  
DOK00030

## CASE DOCKET &amp; HISTORY

11:16:09

Select Function=&gt;



A-Add B-Browse C-Change D-Delete E-Exit F-Find

 FAMILY

PFX	DV	CASE No. (s)	LINAGE	ATTORNEY	CGC No.	SERIAL No	CASE UK
	4	118-6415	.PCT/C5	MMK		08/466,308	13301

PATENT OFFICE		TYP	ATTORNEY	DATE	ACTION / RESPONSE		EXPENSE
DATE:				DUE: 12/09/95	RSTR	RESTRICTION REQUIRED	
ACTN:			<input type="checkbox"/> CASE	RESP: 12/09/95	RSTR	RESTRICTION REQUIRED	
DATE:				DUE: 09/06/95	IDST	INFORMATION DISC/STAT	
ACTN:			<input type="checkbox"/> CASE	RESP: 09/06/95	IDST	INFORMATION DISC/STAT	
DATE:	02/13/98	NOAB	<input type="checkbox"/>	MMK DUE: 09/25/96	AMEN	AMENDMENT	
ACTN:	NOTICE OF ABANDON		<input type="checkbox"/> CASE	RESP: 12/25/96	AMEN	AMENDMENT	
DATE:	02/11/98	NOAB	<input type="checkbox"/>	MMK DUE: 04/11/98	PETR	PETITION TO REVIVE	
ACTN:	NOTICE OF ABANDON		<input checked="" type="checkbox"/> CASE	RESP:			
DATE:				DUE:			
ACTN:			<input type="checkbox"/> CASE	RESP:			

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: )  
STEVEN C. CLARK ET AL. ) : Examiner: Prema Mertz, Ph.D  
Application No.: 08/466,308 ) : Group Art Unit: 1812  
Filed: June 6, 1995 ) :  
For: LYMPHOKINE PRODUCTION ) :  
AND PURIFICATION :  
:

Assistant Commissioner for Patents  
Washington, D.C. 20231

DECLARATION OF LAWRENCE S. PERRY  
UNDER M.P.E.P. § 711.02

Sir:

I, LAWRENCE S. PERRY, DECLARE AND SAY THAT:

1. I am an attorney in the law firm of  
Fitzpatrick, Cella, Harper & Scinto, 277 Park Avenue,  
New York, New York 10172.

2. I am the attorney in Fitzpatrick, Cella,  
Harper & Scinto who is primarily responsible for prosecution  
of the subject patent application. All communications  
received either from Novartis Corporation or the Patent and  
Trademark Office in this application are directed to me  
immediately upon receipt within the firm.

2. On February 18, 1998, a Notice of Abandonment,  
bearing a mailing date of February 11, 1998, was received by

the firm from Novartis Corporation in the above-identified patent application. The Notice of Abandonment stated that the application was abandoned due to Applicant's failure to respond to the Office letter mailed July 11, 1997. However, after reviewing the file jacket, and firm docket records, I conclude that Fitzpatrick, Cella, Harper & Scinto never received the July 11, 1997 Office letter. A photocopy of the relevant page of the computerized docket records is appended.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Dated: March 27, 1998

  
Lawrence S. Ferry

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## Country Applications

Sub record 255327 on Line 1

## C O U N T R Y   A P P L I C A T I O N   D A T A

Case Number: 25.3800PC

Country: USA

Sub Case: 5

Attorney: LSP

United States of America

Case Type: CON

Application Status: PENDING

Application Number: 08/466308

Filing Date: 06/06/95

Patent Number:

Issue Date: / /

Publication Date: / /

Expiration/Abandon Date: / /

Agent:

Agent Reference Number:

Tax Schedule: NL

Paid Thru:

Patent Office Code: 18#

Priority Date: / /

Remarks: #1812; (NO RECORD OF CASE PRIOR TO 011696) (25.3800PCT/C5);

## All Actions

Record 255327 on Line 1 of 7

Case Numbe	Count	Su	Se	Action Due	Date Due	M	Response	Response	Method Se
25.3800PC	USA	5	01	RESP R/E+4X	04/09/96		RSP R/E+4X	04/09/96	COM
25.3800PC	USA	5	02	RESP OA+3X	12/25/96		AMEND/PET	12/24/96	ACS/DCO
25.3800PC	USA	5	03	DWG CORR	11/11/11			/ /	
25.3800PC	USA	5	04		/ /		IDS & \$220	07/16/96	ACS/DCO
25.3800PC	USA	5	#1	AMEND STAT+12	06/26/98			/ /	
25.3800PC	USA	5	05	EXAM/COMM	03/20/97			/ /	
25.3800PC	USA	5	06	PROS SUSPNDED	03/20/97			/ /	

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: )  
STEVEN C. CLARK ET AL. ) : Examiner: Prema Mertz, Ph.D  
Application No.: 08/466,308 ) : Group Art Unit: 1812  
Filed: June 6, 1995 ) :  
For: LYMPHOKINE PRODUCTION ) :  
AND PURIFICATION :  
:

Assistant Commissioner for Patents  
Washington, D.C. 20231

ASSOCIATE POWER OF ATTORNEY AND  
CHANGE IN CORRESPONDENCE ADDRESS

Sir:

This is to appoint LAWRENCE S. PERRY, Registration No. 31,865, as associate attorney in the above-identified application.

All correspondence should be directed as follows:

Lawrence S. Perry  
FITZPATRICK, CELLA, HARPER & SCINTO  
277 Park Avenue  
New York, NY 10172  
Telephone: (212) 758-2400

Respectfully submitted,

Dated: March 25, 1998.

Melvyn M. Kassenoff  
Melvyn M. Kassenoff  
Attorney for Applicants  
Registration No. 26,389

NOVARTIS CORPORATION  
556 Morris Avenue  
Summit, NJ 07901-6955  
Telephone: (908) 522-6927

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UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
08/466,308	06/06/95	CLARK	5 118-6415/PCT
		EXAMINER	
18N2/0711		MERTZ, F.	
		ART UNIT	PAPER NUMBER
		12	
		1812	DATE MAILED: 07/17/97 Rmailed 5/29/98

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

### OFFICE ACTION SUMMARY

Responsive to communication(s) filed on 12/26/96

This action is FINAL.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

#### Disposition of Claims

Claim(s) 1-3, 5-8, 14, 16 is/are pending in the application.  
Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

Claim(s) \_\_\_\_\_ is/are allowed.

Claim(s) 1-3, 5-8, 14, 16 is/are rejected.

Claim(s) \_\_\_\_\_ is/are objected to.

Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

#### Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119

Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All  Some\*  None of the CERTIFIED copies of the priority documents have been

received.  
 received in Application No. (Series Code/Serial Number) \_\_\_\_\_  
 received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

#### Attachment(s)

Notice of Reference Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

SEE OFFICE ACTION ON THE FOLLOWING PAGES--

Art Unit: 1812

### **DETAILED ACTION**

1. The indicated allowability of claims 1-3, 5-8, 14 and 16 is withdrawn in view of the provisional obviousness-type double patenting rejection over co-pending application 08/344,809.

The delay in citation of this rejection is regretted.

2. Claims 1-3, 5-8, 14 and 16 are pending and under consideration by the Examiner.

3. The non-statutory double patenting rejection, whether of the obvious-type or non-obvious-type, is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent. *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Van Ornam*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); and *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321 (b) and © may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application.

See 37 CFR 1.78 (d).

Effective January 1, 1994, a registered attorney or agent of record may sign a Terminal Disclaimer.

A Terminal Disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Art Unit:

Claims 1-3, 5-8, 14, 16 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 11, 16, 23-28, 30 of copending application 08/344,809. Although the conflicting claims are not identical, they are not patentably distinct from each other because they both claim a GM-CSF protein. Claims 1-3, 5-8 of the instant application, Clark et al. (one common inventor, Wang E.), claims "a GM-CSF protein having an amino acid sequence shown in Figure 1 (which encompasses the non-processed protein with the signal sequence)" and claims 14 and 16 claim a GM-CSF composition. In claims 11, 16, 23-27 of application 08/344,809, "a GM-CSF protein composition" having the same sequence as in Figure 1 of 08/466,308 without the signal sequence is claimed, and claims 28, 30 claim a GM-CSF pharmaceutical composition. However, once the entire non-processed protein is obtained, it would have been obvious to one of ordinary skill in the to produce the processed, mature form of the protein, which could be obtained either by isolation from natural sources or by recombinant expression in prokaryotic or eukaryotic host cells, such that the functions of the GM-CSF protein could be studied. Therefore, in the instant invention the claims are broader than in 08/344,809. However, the claims in 08/344,809 are obvious from the instant claims because the instant claims are directed to one specific embodiment encompassed by the claims in 08/344,809.

4. No claims are allowed.

*Advisory information*

Any inquiry concerning this communication should be directed to Prema Mertz whose telephone number is (703) 308-4229. The examiner can normally be reached on Monday-Friday from 8:00AM to 4:30PM (Eastern time).

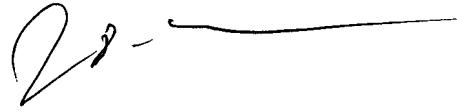
Art Unit:

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Stephen Walsh Ph.D., can be reached on (703) 308-2957.

Papers related to this application may be submitted to Group 1800 in Crystal Mall 1 by facsimile transmission, in conformity with the notice published in the official Gazette, 1096 OG 30 (November 15, 1989). The FAX phone number for Art Unit 1812 is (703) 308-0294.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Prema Mertz Ph.D.  
Patent Examiner  
July 9, 1997



JOHN ULM  
PRIMARY EXAMINER  
GROUP 1800